

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

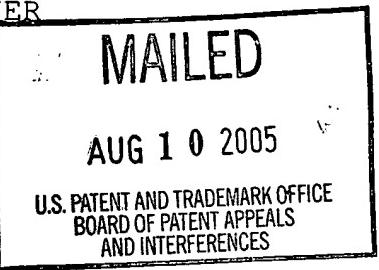
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER KIGHT, RAVI GANESAN, MATT LEWIS,
D. KENNETH HOBDAY, JR., and HANS DREYER

Appeal No. 2005-0221
Application No. 09/892,897

ON BRIEF¹



Before THOMAS, BLANKENSHIP and MACDONALD, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 52.

¹On August 2, 2005, appellants were informed by telephone by Board Administrator Feinberg that there was no need to attend the oral hearing on this appeal set for August 10, 2005, since the above panel has decided to reverse all rejections of the claims on appeal.

Appeal No. 2005-0221
Application No. 09/892,897

Example payment network = ACT P
↓
P Y

43) 6/14/30-51

Representative claim 1 is reproduced below:

1. A method for making payments across multiple payment networks including a first payment network having a first payment service provider and a plurality of associated payers and payees, and a second payment network having a second payment service provider and a plurality of associated payers and payees, comprising:

(1) receiving, at a first payment service provider, a request to make a payment on behalf of a payer to a payee not associated with the first payment network; Wagner
C5; L48-53

transmitting a request of the first payment service provider to determine a payment network within the multiple payment networks with which the payee is associated; C2; L48-51

receiving information indicating that the payee is associated with the second payment network; and C2; L52-53

transmitting a payment instruction from the first payment service provider to the second payment service provider to make the payment to the payee.

The following reference is relied on by the examiner:

Thomas et al. (Thomas) 6,173,272 Jan. 9, 2001

Claims 1 through 52 stand rejected under 35 U.S.C. § 103.

As evidence of obviousness, the examiner relies upon Thomas alone. The examiner has also provisionally rejected claims 1, 5 through 10, 27 and 31 through 36 under the judicially created doctrine of obviousness-type double patenting over certain claims in co-pending application 09/984,568.

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and reply brief for appellants' positions, and to the answer for the examiner's positions.

OPINION

We reverse both stated rejections of the claims on appeal.

Turning first to the provisional obviousness type-double patenting rejection of independent claims 1 and 27 on appeal and respective dependent claims 5 through 10 and 31 through 36, we reverse this rejection. In accordance with the guidance provided in the Manual of Patenting Examining Procedure (MPEP) § 804, II, topic B(1) the examiner must prove that there is an obvious variation of the subject matter of the pending claims that are alleged to conflict between the co-pending applications. The examiner has not presented to us for our review the actual claims from the conflicting application for comparison with the present claims on appeal. The examiner also has not provided any detailed comparison of the actual claim language in the statement of the rejection and remarks at pages 4 and 5 of the answer as well as at pages 7 and 12 of the answer. The examiner has only presented a concept-type of reasoning alleging that the claims recite the same method and system for transferring data across

Appeal No. 2005-0221
Application No. 09/892,897

multiple networks. The examiner further alleges only the intended use of the claims distinguishes them. The alleged intended use differences are stated to be given no patentable weight. The examiner has also set forth no single or two-way obviousness type of analysis.

On the basis of the absence of the examiner's meeting the burden to establish a prima facie case of obviousness-type double patenting, we must reverse the rejection. In contrast, appellants' arguments in the brief at pages 31 and 32 as well as pages 42 through 44 on their face appear to be convincing that the alleged conflicting claims between the respective applications are not obvious variations of each other.

Appellants have set forth extensive two way analyses between the subject matter of the pending claims in this application and those in the alleged conflicting application. In view of all these considerations, the rejection of independent claims 1 and 27 and their respective dependent claims 5 through 10 and 31 through 36 over certain identified claims 53 through 72 of the co-pending application on the doctrine of obviousness-type double patenting is reversed.

Correspondingly, we also reverse the rejection of claims 1 through 52 under 35 U.S.C. § 103 over Thomas alone.

Appeal No. 2005-0221
Application No. 09/892,897

Independent claims 1 and 27 on appeal recite corresponding method and system approaches to common subject matter. The general method for making payment across multiple payment networks requires a first payment service provider to receive a request to make a payment on behalf of a payer to a payee not associated with a first payment network. On the one hand, it does appear according to Thomas' fig. 2A that the respective banks C12 and B16 are to be the first and second payment service providers. The payer station 30 would appear to issue to bank C12 a request to make payment on behalf of a payer to the payee. At this point we must only assume for the sake of argument that the payee is not associated with a first or the same payment network. At this point we also depart from the examiner's reasoning and do not agree with the view taken by the examiner that the respective banks themselves are respective banking networks as argued at page 3 and at the bottom of page 5 of the answer. The art would not consider the banks themselves as networks. To complete our analysis, however, we assume for the sake of argument that this position of the examiner may be correct in the art.

Claim 1 as representative of the features of independent claims 1 and 27, further requires the transmission of a request of a first payment service provider to determine a payment

network within the multiple payment networks required by the claim; the receipt of information indicating the payee is then associated with a second payment network and finally the transmission of a payment instruction from the first payment service provider to the second payment service provider.

Figure 2A of Thomas shows that there does not exist any dialogue (such as bi-directional communication) between the payer 10 (including the payer station 30) and the bank C, element 12, to transmit a request of a first payment service provider to determine a payment network within the multiple payment networks and receiving information back therefrom indicating that the payee is associated with the second payment network as required by the independent claims 1 and 27 on appeal.

Payer
1st payment
Service provider

Likewise, there is no bi-directional dialogue between the bank C, element 12, and the trusted third party (TTP 13) to perform the two claimed functions. It appears to us that either the payer station 30 or the bank C, element 12, must provide the second function of receiving information indicating that the payee is associated with the second payment network. This does not appear to be the case in Thomas. TTP 13 transmits a payment order to the bank B, element 16; TTP 13 does not appear to do both the transmitting the request and receiving the information

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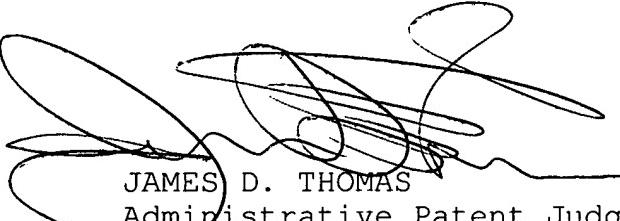
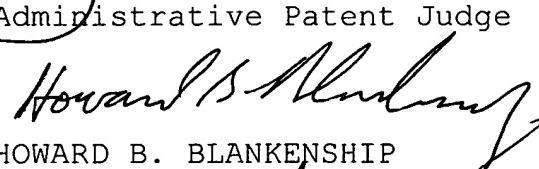
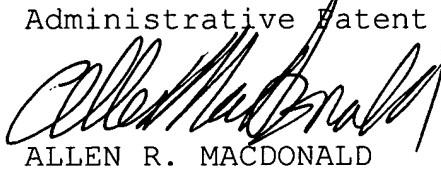
from or in or within itself. We therefore agree with appellants' argument at page 28 of the principal brief on appeal that "Thomas lacks any teaching or suggestion of the payer bank receiving information that the payee is associated with the payee or second bank (or a second payment network)."

Although we agree with the examiner's views expressed at pages 3 and 4 of the answer along with the more expansive views of the examiner at pages 5 through 7 that the representative claimed steps of method independent claim 1 on appeal may be distributed among different entities in the figure 2A showing of Thomas, the actual requirements of the claims do not appear to be met on the basis of any manner in which they may be considered to be performed by different labeled entities in this figure. This appears to be the case even if we consider a more expansive reading of the claim's preamble that uses the word "comprising" as argued by the examiner.

Appeal No. 2005-0221
Application No. 09/892,897

In summary, we have reversed the examiner's provisional obviousness-type double patenting rejection of certain claims on appeal in this application with respect to those of a co-pending application. We have also reversed the rejection of respective independent claims 1 and 27 on appeal under 35 U.S.C. § 103 and thus, correspondingly, the rejection of their respective dependent claims as well. Accordingly, the decision of the examiner is reversed.

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)

HOWARD B. BLANKENSHIP)
Administrative Patent Judge)

ALLEN R. MACDONALD)
Administrative Patent Judge)


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Appeal No. 2005-0221
Application No. 09/892,897

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